

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/573,462

Applicant(s)

KINOSHITA ET AL.

Examiner

Sean P. Cullen

Art Unit

1795

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 March 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: PTO-892 Notice of References Cited.

/Robert Hodge/
Primary Examiner, Art Unit 1795

Continuation of 11, does NOT place the application in condition for allowance because:

Regarding applicant's argument that Hisamitsu et al. does not disclose a discharge circuit be provided within each electric cell (page 7, para. 1), it is noted that the features upon which applicant relies (i.e., a discharge circuit be provided within each electric cell) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claims 14 recites "a discharge circuit is provided on the same surface of at least one layer of the positive-electrode layers, the negative-electrode layers, or the electrolyte layers." Hisamitsu et al. discloses a discharge circuit (50, CU1 and 10-18; Fig. 12) provided on the same surface (10-18, Fig. 12) of the positive-electrode layers (32) or the negative-electrode layers (33). Claim 14 does not require the discharge circuit to be within the electric cell.

Regarding applicant's argument that the photosensor is a separate unit not provided within each cell (page 8, para. 1), the photosensor is one component of the discharge circuit disclosed by Horie et al. Claim 1 does not require the entire discharge circuit be provided within each electric cell. To read on the claim limitation "a discharge circuit provided within each electric cell," a portion of the discharge circuit is provided within each electric cell. Horie et al. discloses a portion of discharge circuit (1) provided within each electric cell (Fig. 4B). Further, Horie et al. discloses a discharge circuit can be installed on the electrode of the cell [0004]. Therefore, Horie et al. discloses a discharge circuit provided within each electric cell.

Regarding applicant's argument that the combination of Horie et al. and Hisamitsu et al. does not teach, suggest or render obvious providing the discharge circuit within each electric cell (page 8, para. 2), Horie et al. discloses a portion of the discharge circuit (1) provided within the electric cell (Fig. 4B); and Hisamitsu et al. discloses a portion of the discharge circuit (10-18) provided within the electric cell (1, Fig. 3). Therefore, Horie et al. and Hisamitsu et al. disclose a discharge circuit provided within each electric cell.

Regarding the applicant's argument that the examiner is ignoring "providing the discharge circuit within each electric cell" (page 8, para. 2), the examiner is giving the claim limitation its broadest reasonable definition, which requires only a portion of the discharge circuit (i.e. a single wire, connection, tab of the discharge circuit) be provided within each electric cell. Therefore, the examiner is not ignoring this important element, but giving this limitation its broadest reasonable definition.

Regarding applicant's argument that Horie et al. does not disclose a discharge circuit (page 8, para. 3), Horie et al. discloses a discharge circuit (1) that electrically senses charged condition of adjacent bipolar electrodes (2 and 3, Figs. 5A-B), but does not disclose a discharge circuit that electrically balances charge conditions. Therefore, Horie et al. discloses a discharge circuit.

Regarding applicant's argument that Hisamitsu et al. does not disclose a discharge circuit provided on the same surface of at least one layer of the positive-electrode layers, the negative-electrode layers or the electrolyte layers (page 8, para. 3), Hisamitsu et al. discloses a discharge circuit (50, CU1 and 10-18; Fig. 12) provided on the same surface (10-18, Fig. 12) of the positive-electrode layers (32), the negative-electrode layers (33) or electrolyte layers (40). The discharge circuit (Fig. 12) is provided on a surface of the bipolar battery (1) that contains the positive-electrode layers (32), the negative-electrode layers (33) and the electrolyte layers (40). Therefore, Hisamitsu et al. discloses a discharge circuit is provided on the same surface of a positive-electrode layers, a negative-electrode layers or a electrolyte layers.

Regarding applicant's argument that Horie et al. does not disclose a discharge circuit (page 9, para. 2), Horie et al. discloses a discharge circuit as detailed above.

Regarding applicant's argument that Hisamitsu et al. discloses circuitry within a controller outside the laminated electrodes (page 9, para. 2), Hisamitsu et al. discloses a portion of the discharge circuit (10-18) laminated within the electric cell (1, Fig. 3).

Regarding applicant's argument that claim 16 is allowable because it is dependent on claim 15 (page 9, para. 2), claim 15 is not allowable as detailed above.

Regarding applicant's argument that Hisamitsu et al. fails to disclose discharge circuitry within each cell (page 9, para. 3), Hisamitsu et al. discloses discharge circuitry (10-18) within each cell (1, Fig. 3) as detailed above.

Regarding applicant's argument that claim 3 is allowable because it is dependent on claim 1 (page 10, para. 1), claim 1 is not allowable as detailed above.

Regarding applicant's argument that claim 4 is allowable because it is dependent on claim 1 (page 10, para. 2), claim 1 is not allowable as detailed above.

Regarding applicant's arguments that a discharge circuit is not provided within each electric cell throughout the response to Office Action dated January 13, 2010, a circuit is defined as "the complete path of an electric current, including the generating apparatus, intervening resistors, or capacitors" (see <http://dictionary.reference.com/browse/circuit>). Therefore, an electric cell electrically connected to a discharge circuit is part of the discharge circuit. Therefore, any discharge circuit connected to an electric cell discloses a discharge circuit provided within each electric cell, as the electric cell is a part of the discharge circuit.